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NAJARIAN, LENA				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/993,663

**Applicant(s)**

SASAKI ET AL.

**Examiner**

LENA NAJARIAN

**Art Unit**

3626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-8, 10-14, 100, 101 and 103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-14, 100, 101 and 103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the Request for Continued Examination (RCE) filed 5/27/08. Claims 1, 5, 7, 8, 12, 14, 100, 101, and 103 have been amended. Claims 2, 9, 15-99, and 102 are cancelled. Claims 1, 3-8, 10-14, 100-101, and 103 are pending.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/25/08 has been entered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3, 4, 6-8, 10, 11, 13, 14, 100, and 103 rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne (US 2005/0060198 A1) in view of Haller et al. (US 2001/0051787 A1).

(A) As per claim 8, Bayne discloses a health management method of managing health of each user carrying a portable terminal, including the steps of:

providing a portable terminal carried by a user with a display screen, radio communication means for accessing a predetermined radio communication network, storage means storing personal information of the user, and an input/output device for supporting health management for the user, (Bayne, Abstract; ¶ 36, 39-41); and

an emergency notification switch to enter an emergency notification mode, (Bayne, ¶ 32, 78).

providing a database for communicating with each portable terminal with personal information storage means storing the personal information about each user carrying the portable terminal, medical information storage means storing information about a medical facility, a drugstore, a medicine, and the input/output device, and communication means for communicating with the portable terminal through the radio communication network, (Bayne, Abstract; ¶ 36, 45-47, 96);

transmitting part of the personal information stored in the storage means by the radio communication means when starting to communicate with the database, (Bayne, Abstract; ¶ 36, 45);

identifying using the database, the user of the portable terminal by collating the part of the information transmitted from the radio communication means with information stored in the personal information storage means, (Bayne, Abstract; ¶ 36, 45); and

activating an emergency handling means which provides either communication with a medical facility whose information is stored in the medical information storage means or information stored in the medical information storage means, which is necessary for the identified user (Bayne, ¶ 32, 50, 78), and

wherein the personal information includes information of a clinical chart of the user and prescription, (Bayne ¶ 93).

Bayne does not disclose that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode.

However, Haller discloses that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode (see paragraph 95 of Haller).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Haller within Bayne. The motivation for doing so would have been for the patient to provide an indication of their health status (para. 228 of Haller).

(B) As per claim 10, Bayne discloses a method wherein the radio communication means and the communication means perform encryption/decryption in accordance with a predetermined scheme in transmitting/receiving at least part of the personal information, (Bayne, ¶ 45).

(C) As per claim 11, Bayne discloses a method wherein the portable terminal acquires position information of the terminal, and information about a route to a suitable medical facility or drugstore is displayed on the display screen on the basis of the position information, (Bayne, ¶¶ 39, 40, 50).

(D) As per claim 13, Bayne discloses a method wherein in the database, when no information is transmitted a predetermined period of time after a specific signal is transmitted from the radio communication means, communication is made to an emergency facility, (Bayne, ¶¶ 77-84) (disclosing automatic emergency call initiation).

(E) As per claim 14, Bayne discloses a method wherein part of the information includes information about biometrical characteristics of the patient, (Bayne ¶¶ 93).

(F) As per claims 1, 3, 4, 6, and 7, these system claims contain the same or similar limitations as the corresponding method claims 8, 10, 11, 13, 14, respectively, and are therefore rejected for the same reasons given above.

(G) As per claim 100, Bayne discloses an information provision method for providing medical information about health, a medical treatment or a medicine from a database, comprising steps of:

receiving, from a portable terminal through a network, user information stored in the portable terminal and an emergency notification for entering an emergency notification mode, (Bayne, ¶¶ 32, 50, 78);

wherein the personal information includes information of a clinical chart of the user and prescription, (Bayne ¶¶ 93).

identifying a user of the portable terminal by collating the user information

transmitted from the portable terminal with personal information stored in the database (Bayne, ¶¶ 32, 50, 78); and

providing either communication with a medical facility or the medical information stored in the database to the portable terminal of the identified user in the emergency notification mode, (Bayne, ¶¶ 32, 50, 78).

Bayne does not disclose that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode.

However, Haller discloses that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode (see paragraph 95 of Haller).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Haller within Bayne. The motivation for doing so would have been for the patient to provide an indication of their health status (para. 228 of Haller).

(H) As per claim 103, Bayne discloses an information provision method wherein the medical information is route information about a suitable medical facility or drugstore for the identified patient, (Bayne, ¶¶ 39, 40, 50).

5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, (U.S. 2005/0060198), in view of Haller et al. (US 2001/0051787 A1), and further in view of Mishevich et al., (U.S. 5,363,842).

(A) As per claim 12, Bayne discloses a health management method of managing health of each user carrying a portable terminal, including the steps of:

providing a portable terminal carried by a user with a display screen, radio communication means for accessing a predetermined radio communication network, storage means storing personal information of the user, and an input/output device for supporting health management for the user, (Bayne, Abstract; ¶ 36, 39-41); and

an emergency notification switch to enter an emergency notification mode, (Bayne, ¶ 32, 78).

providing a database for communicating with each portable terminal with personal information storage means storing the personal information about each user carrying the portable terminal, medical information storage means storing information about a medical facility, a drugstore, a medicine, and the input/output device, and communication means for communicating with the portable terminal through the radio communication network, (Bayne, Abstract; ¶ 36, 45-47, 96);

transmitting part of the personal information stored in the storage means by the radio communication means when starting to communicate with the database, (Bayne, Abstract; ¶ 36, 45);

identifying using the database, the user of the portable terminal by collating the part of the information transmitted from the radio communication means with information stored in the personal information storage means, (Bayne, Abstract; ¶ 36, 45); and

activating an emergency handling means which provides either communication with a medical facility whose information is stored in the medical information storage



means or information stored in the medical information storage means, which is necessary for the identified user, in accordance with information transmitted from said radio communication means (Bayne, ¶¶ 32, 50, 78),

and wherein the personal information includes information of a clinical chart of the patient and a prescription (Bayne ¶¶ 93).

Bayne does not disclose that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode.

However, Haller discloses that the user of the portable terminal is a patient and that the portable terminal carried by the patient enters an emergency notification mode (see paragraph 95 of Haller).

Bayne and Haller fail to disclose a method wherein the input/output device is an inhaler for discharging a medicine in the form of fine droplets to make the user inhale the droplets, and the information about the input/output device includes information about handling of the inhaler. However, such a method is well known in the art as evidenced by Mishelevich, (Mishelevich, Abstract, col. 4, line 35 - col. 5, line 18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the aforementioned features of Mishelevich and Haller within Bayne. The motivation would have been to create a hand-held inhaler device to provide information to both patient and healthcare professional regarding correct usage, actuation, flow rate, and duration, (Mishelevich, col. 4, lines 16-32) and for the patient to provide an indication of their health status (para. 228 of Haller).

(B) As per claim 5, the system claim contains the same or similar limitations as the corresponding method claim 12. As such, claim 5 is rejected for the same reasons given for claim 12 above.

6. Claim 101 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, (U.S. 2005/0060198), in view of Haller et al. (US 2001/0051787 A1), in view of Mishelevich et al., (U.S. 5,363,842), and further in view of Voges, (U.S. 5,894,841).

(A) As per claim 101, the collective system of Bayne, Haller, and Mishelevich fails to disclose a method wherein said portable terminal includes an inhaler which discharges a medicine on the basis of an ink-jet scheme using heat, (Voges, Abstract; col. 4, lines 34-67, col. 5, lines 20-25).

The statement of obviousness and motivation to combine Bayne, Haller, and the inhaler of Mishelevich is as provided in the rejection of claim 12 and incorporated herein.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the ink-jet system of Voges to the collective system of Bayne, Haller, and Mishelevich. The motivation would have been to provide precise dose control, (Voges, col. 2, lines 7-9).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 5, 8, 12, 100, and 101 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a home medical surveillance system (4,838,275).
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/L. N./

Examiner, Art Unit 3626

In

7/15/08

/C Luke Gilligan/

Supervisory Patent Examiner, Art Unit 3626